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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,667	07/02/2003	Richard L. Beard	600-33-DIV	3474

36185 7590 09/14/2004

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/612,667

**Applicant(s)**

BEARD ET AL.

**Examiner**

Thomas McKenzie, Ph.D.

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 14, 15 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10, 14, 15, and 28-33 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This action is in response to an application filed on 3/27/00. There are eighteen claims pending. Claims 1-10, 14, 15, and 28-33 are compound claims. The application concerns some dihydronaphthylene compounds.

***Election/Restrictions***

2. Consistent with the restriction made in parent application 09/533,680, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10, 14, 15, 28-33, and parts of claims 1-9, drawn to compounds where Y is pyridyl, classified in class 546, subclass 364, among others.
- II. Claims parts of 1-9, drawn to compounds where Y is thiophenyl, classified in class 549, subclass 68, among others.
- III. Claims parts of 1-9, drawn to compounds where Y is furanyl, classified in class 549, subclass 480, among others.
- IV. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is pyridazinyl, classified in class 544, subclass 238.
- V. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is pyrazinyl, classified in class 544, subclass 322.
- VI. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is pyrazinyl, classified in class 544, subclass 405.

- VII. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is thiazolyl, classified in class 548, subclass 192.
  - VIII. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is oxazolyl, classified in class 548, subclass 234.
  - IX. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is imidazolyl, classified in class 548, subclass 311.4.
  - X. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is pyrazolyl, classified in class 548, subclass 364.4.
  - XI. Claims parts of 1, 2, and 4-9, drawn to compounds where Y is naphthyl, classified in class 564, subclass 429, among others.
3. Claim 3 link(s) inventions I-III. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 3. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional

statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. Claims 1, 2, and 4-9 link(s) inventions I-XI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1, 2, and 4-9. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

5. The inventions are distinct, each from the other because of the following reasons: the core of the structure given in claim 1 is the ring Y. This aryl or

heterocyclic ring is a mandatory feature and ranges in size from five to ten atoms with multiple possible heteroatoms. These multiple claimed rings are chemically non-equivalent and are not art-recognized as sharing the same biological properties. Inventions I-XI have acquired a separate status in the art as shown by their different classification, thus the patent search required for Group I is not co-extensive with that required for Groups II-XI. The basic names of these heterocycles differ, thus the literature search for these various species will be divergent. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.

6. Should Applicants traverse the restriction requirement on the grounds that the different core rings are not patentably distinguishable, Applicants should identify such evidence now of record or submit any such evidence that shows the groups to be obvious variants. Such evidence may be used in a rejection under 35 USC 103(a) if the Examiner finds any of the Groups unpatentable over the prior art.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Conclusion***

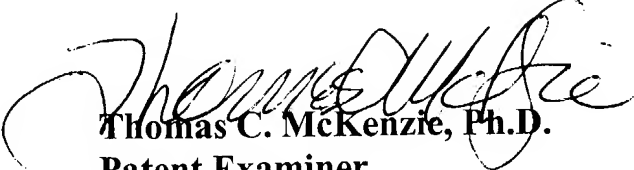
9. Information regarding the status of an application should be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). Please direct general inquiries to the receptionist whose telephone number is (703) 308-1235.

10. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (571) 272-0670. The FAX number for amendments is (703) 872-9306. The PTO presently encourages all applicants to communicate by FAX.

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The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, please contact James O. Wilson, acting SPE of Art Unit 1624, at (571)-272-0661.

  
**Thomas C. McKenzie, Ph.D.**  
**Patent Examiner**  
**Art Unit 1624**  
**(703) 272-0670**

TCMcK/me